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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/696,503

10/29/2003

Gabriel Keita

ESOA:002US

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32425 7590 01/25/2008  
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EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1791

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/696,503	<b>Applicant(s)</b> KEITA ET AL.	
	<b>Examiner</b> Mathieu D. Vargot	<b>Art Unit</b> 1791	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1.Applicant's election without traverse of Group II, claims 15-33 in the reply filed on October 31, 2007 is acknowledged.

2.Claims 16, 17, 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims contain a recitation to a method in claim 1 and this claim is now non-elected. The claims should be amended to include the recitation set forth in claim 1 to replace the language "when tested using the method of claim 1".

3.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-18, 23, 26 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese document 10-146,846 in view of either of Keita et al -689 or Magne -839.

Japanese document -846 discloses the basic claimed method for making a lens by providing a closure member (2) around two mold parts (1) to thereby define a cavity therebetween, with an elastic sealing material (3) bonded to the surface of the closure member, and inserting the tip of a nozzle (instrument) through the elastic sealing material and closure member by puncturing these and introducing a polymerizable composition into the mold cavity through the nozzle. Essentially, the primary reference fails to teach that the sealing material would be at the bottom of the mold apparatus,

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that it would have the property recited in instant claims 16-18 and be made of silicone and the exact time required to polymerize the composition into a lens. While Japanese -846 doesn't show the relative positioning of the sealing material when the composition is introduced into the cavity, either of Keita et al -689 or Magne -839 teach filling a similar mold cavity from the bottom when making a lens. It would have been obvious to one of ordinary skill in the art to have modified the method of Japanese -846 as taught by either of Keita et al -689 or Magne -839 to prevent an excessively long time between filling and polymerization. See Keita et al -689, col. 1, lines 32-45, which discusses the advantages of bottom filling, mentions Magne -839, and teaches that lens compositions are known which polymerize/react in less than 10 minutes. Based on this disclosure, it is submitted that compositions for forming lenses are known to react fairly quickly and the instant polymerization times would certainly have been within the skill level of the art. Concerning the sealing material, Japanese -846 teaches that it is elastic, and such a material would inherently have the instant self-sealing property and would obviously be made of a conventional elastic such as silicone rubber. It is further submitted that due to the self-sealing property that elastic films have, the sealing member of Japanese -846 would exhibit the property set forth in instant claims 16 and 17 when tested.

4. Claims 19-22 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese document 10-146,846 in view of either of Keita et al -689 or Magne -839 and further in view of Su et al -220.

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Japanese –846, Keita et al –689 and Magne –839 are applied for reasons of record, the references failing to teach retracting the instrument out of the cavity and rotating the mold about its horizontal axis. Su et al –220 teaches that filling from the bottom can be problematic in that bubbles would rise directly through the center of the lens. In view of Su et al, it is submitted that one of ordinary skill in the art would have rotated the molds of Japanese –846, when initially the sealing structure is at the bottom, to position the sealing structure somewhere near the top to eliminate air bubbles passing directly through the center of the composition that will become the cured lens.

5. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese document 10-146,846 in view of either of Keita et al –689 or Magne –839 and further in view of Reed et al (see col. 3, lines 6-13).

Japanese –846, Keita et al –689 and Magne –839 are applied for reasons of record, the references failing to teach the aspect of using a vent tape that is attached to the closure member near the top of the cavity. Reed et al discloses such a vent tape and its positioning as set forth in the instant claims would have been obvious in the combination as applied. Certainly, it would have been obvious to have modified the exhaust pipe of Japanese –846 with a vent tape as shown in Reed et al.

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Upon reconsideration and review of the art, it is believed that Japanese document 10-146,846 constitutes a much better primary reference against the claims and hence a new rejection has been offered. Comments submitted May 22, 2007 regarding the

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previous rejection of Keita et al in view of Su et al are now moot, since these references are being relied upon to provide secondary teachings, with newly applied Japanese -846 now the main reference against the claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot  
January 18, 2007

  
Mathieu D. Vargot  
Primary Examiner  
Art Unit 1791

1/18/08